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KRAMER LEVIN NAFTALIS & FRANKEL LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1177 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
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ZALUKAEVA, TATYANA

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PHYLLIS LEITHEM,  
CHARLES A. KREMERS, W. PAUL HARRELL,  
STEPHEN LEWIS, KARL D. SEARS,  
QUAN HE, and PETER R. ABITZ

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Appeal 2008-0222  
Application 09/863,585  
Technology Center 3700

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Before JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, and  
SALLY G. LANE and MICHAEL P. TIERNEY, *Administrative Patent  
Judges*.

MOORE, *Vice Chief Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## I. Background

The Appellants request reconsideration of the Decision of September 4, 2008 (“Decision”) wherein we affirmed the Examiner’s rejection of claim 104, the only appealed claim, under 35 U.S.C. § 103 (a).

We GRANT the request to the extent we have reconsidered the Decision, but we otherwise DENY the relief requested.

## II. Arguments Raised on Rehearing

### a) Whether the Board’s Decision Constituted a New Ground of Rejection

In the Request for Rehearing, the Appellants argue that the Board applied reasoning different than that relied upon by the Examiner to affirm the rejection, therefore resulting in a new ground of rejection. (Request for Rehearing (“Request”) at 2-3).

Specifically, the Appellants urge that “the Examiner found that Novak’s wet laid pulp was a fluffed pulp which could be directly substituted into the structure of Pociluyko.” (*Id.* at 3). According to the Appellants, “[t]he Examiner did not find that the caustic extracted pulp of Novak could be mechanically fluffed and used in the product of Pociluyko.” (*Id.*).

It is well established that there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976).

Moreover, where the statutory basis for the rejection remains the same and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Kronig* at 1303 (reliance

upon fewer references in affirming a rejection under 35 U.S.C. § 103 does not constitute a new ground of rejection).

We initially observe that in the rejection under review in this appeal the Examiner rejected Claim 104 under 35 U.S.C. §103(a) over Novak and Pociluyko. (Non-Final Rejection, Jun. 25, 2004 at 2). Therefore, the underlying statutory and evidentiary basis for the rejection has not changed.

Additionally, in rejecting the claims, the Examiner relied upon Novak as disclosing “a method for making fluff pulp capable of being used for personal hygiene articles, due to its soft and absorbent characteristics.” (Non-Final Rejection at 3) (citing Novak p. 2, col. 1, ll. 15-20). The Examiner found that it would have been obvious to a person of ordinary skill in the art at the time of invention to use “a fluff pulp made by the method taught in Novak” in Pociluyko’s absorbent article. (*Id.*).

These facts support the conclusion that the Examiner regarded and informed the Appellants that the pulp of Novak was a “fluff” pulp, not the felt.

The Examiner also found that “Novak further discloses fluffing the treated wood fiber pulp to form an absorbent sublayer material comprised of fluffed base-treated wood fiber pulp.” (*Id.* at 4) (citing Novak p. 1, col. 2, l. 54 - p. 2, col. 1, ll. 20; p. 2, col. 1, l. 75 -col. 2, l. 11).

The Examiner further explained in the answer that Novak describes circulating the stock in a beater engine and stated that “[t]he process of beating the pulp equates to fluffing.” (Ans. 5) (citing Novak p. 2, col. 1, l. 7 and l. 68-col. 2, l. 11).

These facts further indicate that the Examiner again regarded the Novak pulp as fluffed.

In reply, the Appellant urged that Novak does not teach fluffing, relying on the Specification discussion that to fluff a wood fiber pulp, “it must first be dried and then subjected to dry shredding in a Hammermill or other attrition mill.” (Reply at 2).

The Appellant had fair opportunity to respond to the rejection, evidenced in that the Reply Brief contains a response to the rejection.

The relative positions of the Examiner and the Appellants were considered in the Decision, which concluded that the Appellant was “too narrowly reading” the Novak reference. (Decision at 8).

Appellants have taken the position that the Decision included a new ground of rejection. We are aware that the Appellant feels the Examiner found that the felt must be incorporated into the structure of Pociluyko (Request at 3). We disagree on the reading given both the rejection and the reference.

The Examiner referred to the pulp and not the felt in the rejection (June 25, 2004 Rejection, Page 3). The Appellant referred to the pulp and not the felt in characterizing the rejection in the Appeal Brief (Br. at 7, last line). We referred to the pulp in the decision, not the wet-laid felt. (Decision 7-8).

The decision relied upon the reasoning of the Examiner in the final rejection and answer. None of the art applied, law applied, nor reasoning used, is different in a meaningful way, and the thrust of the rejection did not change. Accordingly, this first argument is unpersuasive.

b) Whether the Panel Incorrectly Found that Appellant Failed to Provide Evidence that the Chatterjee Reference Teaches Away

The Appellants additionally assert that the Board's statement that the Appellants presented no actual argument in their brief that Chatterjee (U.S. Patent 3,932,209) teaches away from the use of uncrossed-linked caustic extract pulp in absorbent personal hygiene devices was erroneous. (Request at 4) (citing Decision at 11). According to the Appellants, "such arguments were made in Appellants' first Appeal Brief on March 17, 2004, and . . . these arguments resulted in the Examiner's withdrawal of the rejection." (Id.).

First, the Appellant is required to present all arguments to be reviewed with respect to each ground of rejection presented for review in the Brief on appeal. 37 CFR § 41.37 (c)(1)(vii) (emphasis added). The Chatterjee reference and the prior rejection were not presented for review in the Substitute Supplemental Brief of December 20, 2006, were not included in that Brief as an argument, and were not pertinent to the decision. Nor are they pertinent to the request for rehearing. The Board reviews rejections presented on appeal and does not scour the record for arguments which may have been made previously resulting in different and withdrawn rejections.

Second, in requesting a rehearing, the Appellant is limited to arguments raised in the briefs. 37 CFR § 41.52 (a)(1). The issue was not raised in the Substitute Supplemental Brief on Appeal relating to the obviousness rejection of claim 104.

Third, even were we to consider the Appellants' March 22, 2004, brief, it contains a single relevant sentence stating that "Chatterjee teaches away from [using non-crosslinked pulp in] the invention." (March 22, 2004 App. Br. at 8). That statement does not constitute a cogent argument with persuasive evidence.

Finally, it bears mentioning that the teaching away argument, to the extent one was made, was also not directly relevant to the rejection presented for review in the prior appeal, which challenged an anticipation rejection.

Accordingly, this second argument is unpersuasive.

c) Whether the Board Failed to Consider Appellants' Evidence of Nonobviousness

The Appellants urge that the following statement in the Decision was in error:

The issue of whether wood fiber pulp as claimed had superior properties and presentation of any superior results (especially those already in the record) should have been addressed in the opening brief. It was not. (Decision at 13).

In essence, the Appellants assert that because arguments were submitted in the March 22, 2004 brief, relating to another, withdrawn, rejection made on a different statutory ground (and over a different reference) those previous arguments should now be considered.

According to the Appellants, these arguments “were implicitly found to be compelling enough for the Examiner to withdraw the then outstanding final rejection of the Claim as anticipated by Chatterjee,” and to decline making a new obviousness rejection based on Chatterjee. (Request at 5). The Appellants further assert that the Examiner’s response “makes it clear that he accepted Appellants’ arguments with respect to Chatterjee teaching away from the claimed invention and Appellants’ evidence of surprising results.” (*Id.*).

Evidence pertaining to the prior rejection and the Chatterjee reference was not put in issue by the Appellants in this appeal. This appeal relates to a

different statutory rejection over a different reference, and the Appellant chose which arguments to present for the Board's consideration in its "Substitute Supplemental Brief."

Accordingly, this third argument is also unpersuasive.

### III. CONCLUSION

In conclusion, based on the foregoing, we have granted Appellants' request to the extent that we have reconsidered our decision as above but we deny the relief sought.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

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KRAMER LEVIN NAFTALIS & FRANKEL LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1177 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036